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10/516,820

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Angelo Benvenuti

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

03/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/516,820 | Applicant(s) BENVENUTI ET AL. | |
| | Examiner Clark F. Dexter | Art Unit 3724 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-9,17-20,22,24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9,17-20,22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 18, 2008 has been entered.

Election/Restrictions

2. Newly submitted claim 25 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim 25, which includes a cutting tool, is directed to the subject matter of non-elected Group IV and is distinct for at least the reasons explained in the Lack of Unity requirement (mailed June 14, 2007).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 25 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

3. Claim 22 is objected to because of the following informalities:
- In claim 22, line 5, --a-- or the like is missing before "distance" for clarity.
- Appropriate correction is required.

Claim Rejections - 35 USC § 112, 2nd paragraph

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-3, 5-9, 17-20, 22 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 23, "products" is vague as to whether it refers to those previously set forth or to other such products; in line 24, "trimmings" is vague as to whether it refers to those previously set forth or to other such trimmings.

In claim 24, line 18, "trimmings" is vague as to whether it refers to those previously set forth or to other such trimmings; also in line 18, "products" is vague as to whether it refers to those previously set forth or to other such products; in line 27, , "products" is vague as to whether it refers to those previously set forth or to other such products; in line 28, "trimmings" is vague as to whether it refers to those previously set forth or to other such trimmings.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5-7 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Rufli, pn 811,332.

Regarding claims 1-3 and 5-7, Rufli discloses a device with every structural limitation of the claimed invention as follows:

- a path (e.g., between 27 and 11) for the products, extending from a product and trimmings entry position and a product delivery position, the trimmings being removed between said entry position and said delivery position (i.e., the device of Rufli is fully capable of performing such a function), and said path being constructed and arranged to receive said trimmings and said products aligned in a row extending substantially parallel to a direction of advancement from said entry position to said delivery position (i.e., the device of Rufli is fully capable of performing such a function);

- extending along said path, a movable flexible member (e.g., 27) to retain and move the products and the trimmings (e.g., the device of Rufli is fully capable of meeting this limitation, particularly given the appropriately configured workpiece/product, such as a “soft” workpiece that is able to be deformed and pressed into the channels formed by features 32 to contact member 27) and an opposite longitudinal fixed element (e.g., 11) to retain said trimmings extending along said path

parallel to a first branch of said flexible member, said fixed longitudinal element being spaced from said first branch of said flexible member so as to allow the products to advance in contact with said flexible member (e.g., with at least 28) and with said fixed longitudinal element;

- at least one pusher (e.g., 16) movable along a feed trajectory, to feed the series of products with the trimmings to said path wherein the pusher is constructed and arranged to feed simultaneously a series of products and trimmings, including a lead trim and a trailing trim, while in contact with each other and aligned in said row parallel to the direction of advancement between said flexible member and said fixed longitudinal element (i.e., the device of Rufli is fully capable of performing such a function); wherein said feed trajectory of the pusher intersects the path of the products between said flexible member and said fixed longitudinal element, overlapping in a final stretch (e.g., in the same manner as the present invention) of the path of the products in contact with said flexible member and said fixed longitudinal element;

[claim 2] wherein said products are rolls of wound web material and said trimmings are head and tail trimmings produced by cutting rolls or logs (this claim is directed to the workpiece/product which is not part of the claimed invention);

[claim 6 (from 2)] wherein the fixed longitudinal element and the first branch of the flexible member are operatively spaced relative to one another so as to receive rolls of wound web material and trimmings therefrom (e.g., the device of Rufli is fully capable of meeting this limitation, particularly given the appropriately configured workpiece/product);

[claim 3] wherein said fixed longitudinal element is at a lower height than said flexible member (e.g., see Fig. 2);

[claim 5 (from 3)] wherein said first branch of the flexible member is approximately vertically overlapping said fixed longitudinal element (e.g., see Fig. 2);

[claim 7] wherein said flexible member extends upstream of said fixed longitudinal element, in relation to the a direction of feed of the products (e.g., as viewed in Fig. 2, element 27 extends to the right which is an upstream direction of element 11 in relation to a direction of feed of the workpieces/products, and in particular, element 27 extends upstream of element 11 when element 11 is fixed in the raised position (shown in phantom in Fig. 2)).

Regarding claim 24, Rufli discloses a device with every structural limitation of the claimed invention as follows:

- a path (e.g., between 27 and 11) for the products, extending from a product and trimmings entry position and a product delivery position, the trimmings being removed between said entry position and said delivery position (i.e., the device of Rufli is fully capable of performing such a function), and said path being constructed and arranged to receive said trimmings and said products aligned in a row extending substantially parallel to a direction of advancement from said entry position to said delivery position (i.e., the device of Rufli is fully capable of performing such a function);

- extending along said path, a movable flexible member (e.g., 27) to retain and move the products and the trimmings (e.g., the device of Rufli is fully capable of meeting this limitation, particularly given the appropriately configured workpiece/product, such as a "soft" workpiece that is able to be deformed and pressed into the channels formed by features 32 to contact member 27) and an opposite longitudinal fixed element (e.g., 11) to retain said trimmings extending along said path parallel to a first branch of said flexible member, said fixed longitudinal element being positioned and spaced from said first branch of said flexible member so that the flexible member contacts trimmings and products on a top surface thereof and the fixed longitudinal element contacts these trimmings and products on another surface thereof opposite the top surface so as to allow the products to advance in contact with said flexible member (e.g., with at least 28) and with said fixed longitudinal element;

- at least one pusher (e.g., 16) movable along a feed trajectory, to feed the series of products with the trimmings to said path; wherein the pusher is constructed and arranged to feed simultaneously a series of products and trimmings, including a lead trim and a trailing trim, while in contact with each other and aligned in said row parallel to the direction of advancement between said flexible member and said fixed longitudinal element (i.e., the device of Rufli is fully capable of performing such a function); wherein said feed trajectory of the pusher intersects the path of the products between said flexible member and said fixed longitudinal element, overlapping in a final stretch (e.g., in the same manner as the present invention) of the path of the products in contact with said flexible member and said fixed longitudinal element; and wherein said

flexible member and said fixed longitudinal element are arranged relative to one another to cause the trimmings to overturn due to an overturning torque applied thereon by said flexible member and said fixed longitudinal element (i.e., the last limitation does not clearly set forth any additional structure, and Rufli discloses structure that is “arranged relative to one another” such that the device of Rufli is fully capable of performing such a function).

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 22 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rufli, pn 811,332.

Rufli discloses a device with every structural limitation of the claimed invention as follows:

[claim 22] wherein said fixed longitudinal element and said flexible member are positioned on opposite sides of a vertical median plane of symmetry of the products fed along said path; distance between said fixed longitudinal element and said flexible member in a plan projection being adjustable to handle products of variable diameters when received and fed along said path (e.g., the device of Rufli is fully capable of meeting this limitation as best understood, particularly given the appropriately configured workpiece/product); and the dimension and form of said pusher are such that during action of said pusher to feed the products to said path between the flexible member and the fixed longitudinal element the pusher does not interfere with said fixed longitudinal element and said flexible member.

In the alternative, if it is argued that Rufli does not disclose adjustable structure that meets the limitation “distance between said fixed longitudinal element and said flexible member in a plan projection being adjustable”, the Examiner takes Official notice that such adjustable structure is old and well known in the art and provides various well known benefits including adaptability to various kinds/dimensions of workpieces. Therefore, it would have been obvious to one having ordinary skill in the art to provide such adjustable structure on the device of Rufli to gain the well known benefits including that described above.

Claim Rejections - 35 USC § 103

10. Claims 8, 9 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruffli, pn 811,332.

Ruffli discloses a device with almost every structural limitation of the claimed invention but lacks:

[claim 8] wherein said flexible member has a feed speed, along said path, greater than a feed speed imparted on the products by said at least one pusher;

[claim 9] wherein spacing between the flexible member and the fixed longitudinal element is adjustable;

[claim 17] wherein said fixed longitudinal element comprises a synthetic material with a low friction coefficient;

[claim 18 (from 17)] wherein said synthetic material is polytetrafluoroethylene (Teflon);

[claim 19] wherein said fixed longitudinal element has a laminar extension, with a rounded surface in contact with the products;

[claim 20 (from 19)] wherein said fixed longitudinal element has a reduced height in proximity to the product and trimmings entry position.

Regarding claim 8, the Examiner takes Official notice that it is old and well known in the art to provide material conveyors of different speeds (or variable speeds) for various well known benefits including adjusting the spacing between work pieces. For example, it is old and well known in the art to decrease the speed of a first conveyor

leading to a second, faster conveyor to increase spacing between the work pieces, and to increase the speed of the first conveyor relative to the second conveyor to reduce the spacing between work pieces. Therefore, it would have been obvious to one having ordinary skill in the art to provide conveyors (e.g., including a movable flexible member and a pusher) having the claimed relative speeds to gain the well known benefits including those described above.

Regarding claim 9, the Examiner takes Official notice that it is old and well known in the art to provide a workpiece supports and conveyors with variable spacing therebetween for various well known benefits including facilitating the processing of different sized work pieces. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a variable spacing support/conveyor configuration to gain the well known benefits including that described above.

Regarding claims 17-20, the Examiner takes Official notice that such workpiece support configurations are old and well known in the art and provide various well known benefits including ease of manufacture, ease of handling and reduced wear/friction characteristics. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a longitudinal element configuration on the apparatus of Rufli for the well known benefits including those described above.

Response to Arguments

11. Applicant's arguments filed December 18, 2008 have been fully considered but they are not persuasive. It is respectfully submitted that applicant continues to argue

how the present invention is used in a different manner for a different purpose as compared to the applied prior art. However, it is respectfully submitted that applicant has not further or adequately defined the claimed invention in terms of its structural differences to structurally distinguish the claimed invention over the prior art. It is again emphasized that the Examiner's position is not that the prior art is used in the same manner or for the same purpose as the present invention. Rather, the Examiner's position is that the prior art teaches or suggests all of the structure set forth for the claimed invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/
Primary Examiner, Art Unit 3724**

cfd
March 14, 2009